

REMARKS/ARGUMENTS

Claims 1-6 and 48-53 have been canceled without prejudice for re-presentation in a continuing application.

Claims 7, 8, 10, 12, 14, 15, 17, 23, 24, 32, 35, 39, 42, 45, 46, 54, and 55 have been revised to better tailor the claims to the election below and currently contemplated commercial embodiments of the invention. The revisions are made for business reasons unrelated to any position set forth in the Restriction Requirement.

Support for the revisions to independent claims 7, 14, 23, 32, and 39 is provided at least on page 4, lines 16-30; page 8, lines 22-26; page 11, description of Figure 7; page 48, lines 5-12; and Figure 7 of the application as filed. Support for the revisions to claims 54 and 55 is provided at least by a comparison of the sequences that are relevant to HoxB13 and IL17BR.

New claims 56-67 are supported at least by the claims as previously presented and the application as filed, as well as revised claims 54 and 55.

No new matter has been introduced, and entry of the revised claims is respectfully requested.

RESPONSE TO RESTRICTION

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement sets forth the following Groups:

Group I, claims 1-6 and 48-53;

Group II, claims 8-11, 15-18, 20-22, 24-27, 29-31, 33-36, 40-45, and 54-55; and

Group III, claims 8-9, 12-13, 15-17, 19-22, 24-26, 28-31, 37-38, and 46-47.

Claims 7, 14, 23, 32, and 39 are alleged to link Groups II and III.

The Restriction Requirement further states that “the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability...” (see bridging paragraph, pages 6-7 of the Restriction Requirement).

Applicants understand the above to indicate that should Group II or Group III be elected, linking claims 7, 14, 23, 32, and 39 will be examined with the elected Group and should the linking claims be found allowable, the claims of the remaining Group will be rejoined.

Should the above understanding be incorrect, Applicants respectfully traverse the assertion of Groups II and III as separate inventions that are “linked inventions.” Applicants point out that the alleged separation of the claims into Groups II and III appears to reflect a failure to recognize that the claims are directed to a genus, for example as reflected in claims 7, 14, 17, 23, 26, 32, and 39, as well as two representative species: assays via nucleic acid or protein detection. The alleged separation into Groups II and III appear to be separation into the two representative species, but without recognition of the genus claims.

Recognition of the presence of genus claims is important because Applicants regard the genus as their invention. Any attempt to restrict the genus to be merely species thereof would deny Applicants the ability to seek claims directed to what they regard as the invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02. These decisions clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a genus claim. Therefore, and by way of example, claims 7, 14, 17, 23, 26, 32, and 39 cannot be divided by restriction.

In light of the above arguments, and should the understanding of the prosecution of “linked inventions” indicated above be incorrect, Applicants respectfully request reconsideration and modification of the instant Restriction Requirement in favor of one group comprising pending claims 7-47 and 54-67 with recognition of genus claims 7, 14, 17, 23, 26, 32, and 39.

In the event that the above understanding regarding “linked inventions” be correct, or the Restriction Requirement is nevertheless maintained, Applicants elect Group II, claims 8-11, 15-18, 20-22, 24-27, 29-31, 33-36, 40-45, and 54-55, with traverse for the reasons provided above. New claims 56-67 are believed to correspond to this elected group.


Additionally, and with respect to the Requirement for “one specific polynucleotide/polypeptide combination to which the claims will be restricted”, Applicants respectfully elect the combination of HoxB13 expression and IL17BR expression as a ratio thereof. This combination is reflected in claims 7-31, for example. The election of this combination reflects the underlying feature of the claimed methods as including assays for expression of each of HoxB13 and IL17BR, which is reflected in claims 32-47.

In the interest of advancing prosecution, Applicants respectfully point out that the invention of claims 7-31 may be viewed as a combination relative to the invention of claims 32-47, which feature a subcombination thereof. Applicants respectfully point out that standards for the prosecution of combination/subcombination situations is set forth at MPEP 806.05(c).

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6151.

Respectfully submitted,


Kawai Lau, Ph.D.
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
Attachments
KL:ps 60792819 v1